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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,614	01/26/2004	Gordon Tullos	A01490	8927

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ROHM AND HAAS COMPANY
PATENT DEPARTMENT
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EXAMINER

FEELY, MICHAEL J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/764,614

Applicant(s)

TULLOS ET AL.

Examiner

Michael J. Feely

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 0103.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Pending Claims

Claims 1-10 are pending.

Claim Interpretation

1. The instant invention comprises a blend of: (1) a first coating powder comprising an opacifier, a pigment, or a combination opacifier and pigment; and (2) a second coating powder comprising an opacifier, a pigment, or a combination of opacifier and pigment; wherein the opacifier and/or pigment of (1) is different from the opacifier and/or pigment of (2) in type and/or amount; and wherein the difference provides optical mouse activity to the overall blend.

In essence, the claimed invention comprises a blended powder coating composition comprising at least one opacifier/pigment (amount-difference yields one blended amount) or at least two opacifiers/pigments (type-difference yields a blended amount of two distinct opacifiers/pigments).

Claim Rejections - 35 USC § 102/103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ilenda et al. (US Pat. No. 6,861,475).

The applied reference has a common assignee with the instant application; however, the inventive entity is different. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

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Regarding claims 1-10, Ilenda et al. disclose: *(1)* a coating powder formulation (Abstract) comprising: a blend of a first coating powder and a second coating powder compatible with the first coating powder (column 3, line 49 through column 4, line 15; Tables 2 & 3) wherein the *overall blend comprises at least one* opacifier, pigment, or a combination of opacifier and pigment (column 11, lines 28-55; Tables 2 & 3) or the *overall blend comprises at least two* opacifiers, pigments, or a combination of opacifier(s) and pigment(s) (column 11, lines 28-55; Tables 2 & 3);

(2) wherein the coating powder compositions comprise an epoxy resin (column 3, line 49 through column 4, line 15; Tables 2 & 3), a low temperature curing agent (column 8, line 49 through column 9, line 35; Tables 2 & 3), and a catalyst (column 8, line 49 through column 9, lines 35; Tables 2 & 3);

(3) wherein the epoxy resin has an equivalent weight of from 100 to 700 (column 3, line 49 through column 4, line 15; Tables 2 & 3), the low temperature curing agent is an epoxy resin adduct of an aliphatic polyamine (column 8, line 49 through column 9, line 35; Tables 2 & 3), and the catalyst is an imidazole having the formula *see claim for structure* or an epoxy adduct thereof wherein R₁, R₂, R₃, and R₄ are independently hydrogen, alkyl, aryl or alkaryl (column 8, line 49 through column 9, line 35; Tables 2 & 3);

(4) wherein from 1 to 20 weight percent of the total weight of the epoxy resin is crystalline (column 3, line 49 through column 4, line 15; Tables 2 & 3);

(5) wherein the *overall blend comprises at least one* pigment (column 11, lines 28-55; Tables 2 & 3);

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(6) wherein the *overall blend comprises at least two pigments* (column 11, lines 28-55; Tables 2 & 3); wherein the first pigment has a first hue and the second pigment has a second hue different from the first hue (column 11, lines 28-55; Tables 2 & 3);

(8) a method of forming a coated article comprising applying to a surface of a substrate the coating powder formulation of claim 1, fusing the applied coating powder formulation, and optionally curing the applied, fused coating powder (column 13, lines 24-44); (9) wherein the substrate comprises wood (column 14, lines 20-34); and

(10) a powder coating formed from the composition of claim 1 (Abstract; Tables 2 & 3).

Ilenda et al. do not explicitly disclose: (1) wherein the pigment(s) and/or opacifier(s) provide optical mouse activity to a powder coating formed from the blend; and (7) wherein the delta E between the first and second powder coating compositions is greater than two.

With respect to the delta E limitation, it appears that the overall blend of Ilenda et al. would have been inherently capable of being divided into portions giving a delta E of greater than two. This is because the material and quantity limitations of the instant invention are fully satisfied by the disclosure (*including Examples*) of Ilenda et al.

With respect to the optical mouse activity, it appears that the overall blend of Ilenda et al. would have inherently featured optical mouse activity. This is because of its low gloss nature and because the material and quantity limitations of the instant invention are fully satisfied by the disclosure (*including Examples*) of Ilenda et al.

It has been found that, "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable.

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Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present – *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Therefore, the composition of Ilenda et al. would have: (a) been inherently capable of being divided into portions giving a delta E of greater than two; and (b) inherently featured optical mouse activity. This is because the material and quantity limitations of the instant invention are fully satisfied by the low gloss powder coating composition of Ilenda et al., and it has been found that a chemical composition and its properties are inseparable.

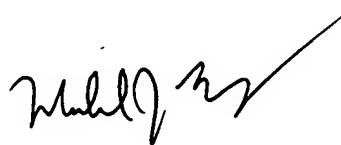
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Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Feely whose telephone number is 571-272-1086. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael J. Feely
Primary Examiner
Art Unit 1712

February 20, 2006

**MICHAEL FEELY
PRIMARY EXAMINER**